

## **REMARKS**

Applicants acknowledge receipt of an Office Action dated January 31, 2007. In this response, Applicants have cancelled claims 14-17 and 19-21 without prejudice or disclaimer. Applicants have cancelled these claims solely to expedite prosecution of the remaining claims and expressly reserve the right to pursue the subject matter of these claims in one or more continuation, divisional, or reissue application.

In addition, Applicants have amended claims 2, 3, 6, 9-12, and 18 to make these claims depend from claim 13. Entry of these amendments following issuance of a final rejection is believed proper inasmuch as these amendments simply cancel claims, change the dependency of certain dependent claims as a result of the cancellation of claims, or resolve minor §112, 2<sup>nd</sup> paragraph issues.

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

### **PTO Response to Applicants' Previous Arguments**

Applicants expressly traverse the PTO's suggestion that a person of ordinary skill in the art would understand the presently claimed motor vehicle as encompassing a "remote controlled battery operated toy car." Applicants also expressly traverse the PTO's statement regarding scaling up the battery of Hanafusa and regarding the positively recited structure and claim preambles. Applicants expressly reserve the right to present arguments and address these issues in more detail in future responses in the present application and/or one or more continuing, divisional, or reissue applications.

### **Rejections Under 35 U.S.C. §112, 1<sup>st</sup> Paragraph**

On page 2 of the Office Action, the PTO rejected claims 11, 14, and 19 under 35 U.S.C. §112, 1<sup>st</sup> Paragraph as allegedly being non-enabled. While Applicants traverse this rejection, in an effort to expedite prosecution, Applicants have cancelled claims 14 and 19 without prejudice or disclaimer and have amended claim 11 to cancel the phrase "with sufficient energy density and power to serve as a driving source for a vehicle." Applicants

expressly reserve the right to pursue this cancelled subject matter in one or more continuing, divisional, or reissue applications.

### **Rejections Under 35 U.S.C. §112, 2<sup>nd</sup> Paragraph**

On page 2 of the Office Action, the PTO rejected claims 11, 14, 18, and 19 under 35 U.S.C. §112, 2<sup>nd</sup> Paragraph as allegedly being indefinite.

In this response, in an effort to expedite prosecution, Applicants have cancelled claims 14, and 19 without prejudice or disclaimer and have amended claim 11 to cancel the phrase “with sufficient energy density and power to serve as a driving source for a vehicle.” Accordingly, the rejection of these claims under §112, 2<sup>nd</sup> paragraph is now moot.

With regard to claim 18, Applicants have amended claim 18 in a manner consistent with the PTO’s discussion in the Office Action and consistent with exemplary depictions and discussion in the Specification including, for example, Fig. 6 and the corresponding discussion in the Specification. Applicants note that this amendment does not narrow the scope of claim 18.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection of claim 18 under §112, 2<sup>nd</sup> paragraph.

### **Rejections Under 35 U.S.C. §103**

On pages 5-9 of the Office Action, the PTO has issued a number of rejections under 35 U.S.C. §103 which Applicants have summarized for reference:

- On page 5 of the Office Action, the PTO has rejected claims 2-4, 6, 9-12, and 17-21 under 35 U.S.C. §103(a) as allegedly being unpatentable over EP 1160895 to Hanafusa *et al.* (hereafter “Hanafusa”) in view of JP 2001-256934 to Osaka *et al.* (hereafter “Osaka”), JP 2001-114157 to Takahashi *et al.* (hereafter “Takahashi”), and U.S. Patent 5,879,831 to Ovshinsky *et al.* (hereafter “Ovshinsky”).
- On page 7 of the Office Action, the PTO has rejected claim 5 under 35 U.S.C. §103(a) as allegedly being unpatentable over Hanafusa in view of Osaka, Takahashi and Ovshinsky and further in view of U.S. Patent 6,821,671 to Hinton *et al.* (hereafter “Hinton”).

- On page 7 of the Office Action, the PTO has also rejected claim 7 under 35 U.S.C. §103(a) as allegedly being unpatentable over Hanafusa in view of Osaka, Takahashi and Ovshinsky and further in view of U.S. Patent 5,688,615 to Mrotek *et al.* hereafter “Mrotek”).
- On page 8 of the Office Action, the PTO has rejected claim 8 under 35 U.S.C. §103(a) as allegedly being unpatentable over Hanafusa in view of Osaka, Takahashi and Ovshinsky and further in view of U.S. Patent 6,517,966 to Marukawa (hereafter “Marukawa”).
- On page 8 of the Office Action, the PTO has also rejected claims 13 and 15 under 35 U.S.C. §103(a) as allegedly being unpatentable over Hanafusa in view of Osaka.
- Finally, on page 9 of the Office Action, the PTO has rejected claims 14 and 16 under 35 U.S.C. §103(a) as allegedly being unpatentable over Hanafusa in view of Osaka and further in view of Ovshinsky.

With regard to claims 14-17 and 19-21, Applicants note that these claims have been cancelled without prejudice or disclaimer. In addition, Applicants note that claims 2-12 and 18 have been amended such that each of these claims now ultimately depends from claim 13. These amendments alone have rendered moot all of the rejections under §103 except the rejection of claim 13 based upon the combination of Hanafusa and Osaka which Applicants traverse for the reasons set forth below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants’ disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Here, Applicants submit that Hanafusa and Osaka, taken either individually or in combination, fail to teach or suggest “a pair of electrode tabs connecting to the power generating element and protruding from the film” as recited in independent claim 13. For this

reason, Applicants submit that the outstanding rejection of claim 13 is improper and ought to be withdrawn.

Still further, Applicants submit that Hanafusa and Osaka, taken either individually or in combination, fail to teach or suggest a packing case provided with "an opening for each of the electrode tabs to extend out from the packing cases and connect to each other, wherein each of the openings is arranged linearly." For this additional reason, Applicants submit that the outstanding rejection based upon Hanafusa and Osaka is improper and ought to be withdrawn.

If an independent claim is nonobvious under §103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that claims 2-12 and 18, which ultimately depend from independent claim 13, are also non-obvious.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections under §103.

### **CONCLUSION**

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By 

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